



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,796	12/26/2001	Mark Thompson	020375-003900US	7212
20350	7590	08/23/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			BURGESS, BARBARA N	
			ART UNIT	PAPER NUMBER
			2157	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/032,796	THOMPSON ET AL.
Examiner	Art Unit	
Barbara N. Burgess	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 06 June 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-16 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: ____ .

DETAILED ACTION

This Office Action is in response to amendments filed June 6, 2005. Claims 1-15 are presented for further examination. Claim 16 is presented for initial examination.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldschlag et al. (hereinafter “Gold”, US 6,108,644).

As per claim 1, Gold discloses a method for auditing forms, the method comprising:

- Issuing a request to provide a form identifier that is associated with a form (column 8, lines 5-15, 57-60);
- Receiving the identifier at a host computer (column 8, lines 9-12, 59-65);
- Verifying with the host computer whether the identifier is a valid identifier for the form being used (column 8, lines 16-21, 65-67, column 9, lines 1-2).

As per claim 2, Gold discloses a method as in claim 1, wherein the request is issued from a terminal having a processor that is in communication with the host computer, and further comprising logging an error if the identifier is not valid (column 4, lines 44-60).

As per claim 3, Gold discloses a method as in claim 2, wherein the request is sent from the host computer to the terminal (column 8, lines 57-59).

As per claim 4, Gold discloses a method as in claim 1, where the request is issued from a customer service operator over a phone (column 1, lines 19-25, column 2, lines 55-61, column 3, lines 55-63).

As per claim 5, Gold discloses a method as in claim 2, wherein the identifier is received at the host computer from the terminal (column 8, lines 9-12, 59-65).

As per claim 6, Gold discloses a method as in claim 1, wherein the host computer includes an associated database, and wherein the identifier is verified by comparing the identifier with a list of valid identifiers in the database (column 9, lines 23-26, column 10, lines 14-16, column 12, lines 17-20, 45-46, 55-56).

As per claim 7, Gold discloses a method as in claim 1, further comprising determining whether an appropriate form has already been ordered (column 10, lines 8-14).

As per claim 8, Gold discloses a method as in claim 7, wherein if an appropriate form has not been ordered, placing an order for an appropriate form (column 10, lines 14-18).

As per claim 9, Gold discloses a method as in claim 8, further comprising evaluating whether the ordered form is received by a user (column 10, lines 8-14).

As per claim 10, Gold discloses a method as in claim 9, further comprising transmitting an identifier for a replacement form to the host computer (column 10, lines 8-20).

As per claim 11, Gold discloses a forms auditing system, comprising:

- A host computer (column 8, lines 9-12, 59-65);
- A database associated with the host computer, the database having a record of a set of forms and a valid identifier for each of the forms (column 9, lines 23-26, column 10, lines 14-16, column 12, lines 17-20, 45-46, 55-56);
- Wherein the host computer is configured to receive an identifier in response to a request to audit a form, and to verify whether the identifier is a valid identifier for the audited form by comparing the identifier with the identifiers in the database, and to produce a record in the database of the comparison (column 8, lines 16-21, 65-67, column 9, lines 1-2).

As per claim 12, Gold discloses a system as in claim 11, further comprising a terminal having a processor, wherein the terminal is configured to receive the identifier of the form being audited and to electronically send the identifier to the host computer (column 8, lines 9-12, 59-65).

As per claim 13, Gold discloses a system as in claim 12, wherein the terminal is configured to produce an audit screen having a region for inputting the identifier (column 8, lines 5-10, 60-64).

As per claim 14, Gold discloses a system as in claim 13, wherein the terminal is configured to produce the audit screen based on information sent to the terminal from the host computer (column 8, lines 58-60).

As per claim 15, Gold discloses a system as in claim 11, wherein the host computer is configured to generate an error report if the identifier of the form being audited is not valid (column 10, lines 14-16, column 12, lines 17-20, 45-46, 55-56).

3. Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Chang et al. (hereinafter "Chang", US Patent 6,105,012).

As per claim 16, Chang discloses a forms auditing system, comprising:

- A form identifier that is associated with a form (column 5, lines 55-58, column 8, lines 7-14, column 10, lines 28-35);
- A host computer (column 1, lines 66-67, column 2, lines 1-10, column 3, lines 54-65);

- A database associated with the host computer, the database having a record of a set of forms and a valid form identifier for each of the forms (column 3, lines 1-4, column 4, lines 63-64, column 5, lines 1-6);
- Wherein the host computer is configured to receive the form identifier in response to a request to audit a form, and to verify whether the form identifier is a valid form identifier for the form to be audited by comparing the form identifier with the valid form identifiers in the database, and to produce a record in the database of the comparison (column 2, lines 59-61, column 5, lines 55-60, column 6, lines 20-30, column 8, lines 61-67).

Response to Arguments

The Office notes the following arguments:

- (a) It is requested that the Examiner issue an Office Action with the correct claims in light of the Preliminary Amendment.
- (b) Goldschlag cannot be relied on to teach or suggest issuing a request to provide a *form identifier* that is associated with a *form* and receiving the *identifier* at a host computer, or *verifying* with the host computer whether the *identifier* is a valid *identifier* for the *form* being used.
- (c) There is no *form*, instead a *transaction*.

4. Applicant's arguments filed have been fully considered but they are not persuasive.

In response to:

(a) Examiner has examined the claims in view of the Preliminary Amendment.

(b)-(c) According to Applicant's Description of Invention, forms may be forms printed on some type of media, such as paper, that have regions or fields for entering various types of information. For example the fields may relate to various business information such as customer name and address, goods being purchased or shipped, a monetary value, a payee or vendor, and the like (page 3, lines 7-15).

According to Goldschlag, a customer registers with a vendor to obtain a validated certificate that will be used to enable the customer to perform transactions. When the customer or subscriber registers with the vendor, the customer must provide information in fields (form) pertaining to the customer's identity such as customer identifier, audit secret, password, access code, etc. The vendor stores this information from the customer and uses it to validate the customer and the customer's transaction.

Therefore, when the customer initiates a transaction, the vendor requests the customer to provide identifying information in order to validate the customer. However, during an audit, the vendor sends an audit request message requesting an identifier. The customer returns a message including an audit secret and customer identifier. The vendor compares this information to the information entered by the user during the registration process (form) to determine its legitimacy (column 5, lines 51-65, column 7, lines 57-61, 66-67, column 8, lines 1-11, 16-25, 57-67, column 9, lines 1-14).

Therefore, Goldschlag clearly discloses a *form identifier* that is associated with a *form* and receiving the *identifier* at a host computer, and *verifying* with the host computer whether the *identifier* is a valid *identifier* for the *form* being used.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US PG Publication 2003/0097317

US Patent No. 6,154,753

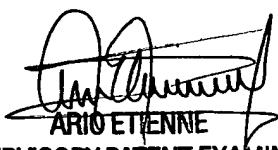
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara N. Burgess whose telephone number is (571) 272-3996. The examiner can normally be reached on M-F (8:00am-4:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Barbara N Burgess
Examiner
Art Unit 2157

August 20, 2005



Barbara N. Burgess
ARIE ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100